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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/057,781	04/09/1998	YUICHI TAKATSU	65316-002	6772

10291 7590 10/03/2002

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EXAMINER

SOUGH, HYUNG SUB

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/057,781

Applicant(s)

TAKATSU ET AL.

Examiner

Hyung S. Sough

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-20,22,24 and 28-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-20,22,24 and 28-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 16.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3621

1. **Examiner noted the discrepancy between the instant application and the foreign priority document (JP 9-92348). More specifically, the instant application includes figures 8-15 which are not in the foreign priority document (JP 9-92348).**

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 28-43 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Elements will perform the claimed functions that critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The rejected claims are directed to a device for the recited functions, but no elements that will make the device to perform the recited functions are positively recited.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-20, 28-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3621

- Claims 1, 4, 44, and 45, lines 11-13, “determining if said authorization information represents a generation request for said electronic note of an about equal to or greater than said predetermined amount” cannot be clearly understood. More specifically, in lines 6-8 of the claim states “presenting said authorization information to said electronic note generation means via said network to request generation of an electronic note of a predetermined amount”. Thus, “said authorization information represents a generation request for said electronic note” should have the request of “a predetermined amount” rather than “an about equal to or greater than said predetermined amount” as recited in lines 11-13.

- Claims 3 and 5-20, “The electronic commerce system” does not have proper antecedent basis.

- Re claims 28-43: as stated supra, the rejected claims do not recited element(s) and the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty. *In re Wiggins*, 488 F.2d 538, 179 USPQ 421 (CCPA 1973).

- Claims 46 and 47, lines 7 and 8, “said predetermined amount” does not have proper antecedent basis.

Applicant is advised to carefully review all the claims for further needed corrections.

Art Unit: 3621

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claim 48 rejected under 35 U.S.C. 102(e) as being anticipated by Biffar (US PAT. 5,903,880).

Biffar (e.g., col. 3, line 16- col. 5, line 24) discloses a recording medium which is readable by a computer and has stored a program for allowing a computer to function as an electronic note generation device for:

determining whether or not to generate information representing a predetermined amount based on an identification code (i.e., "identifying element") which is indicative of a right to request generation of said information representing an amount equal to or smaller than a predetermined

Art Unit: 3621

credit limit, when supplied with said identification code by an outside device connected via a network to request generation of said information representing said predetermined amount, generating and sending said information representing said predetermined amount to said outside device when determining to generate said information: and

handling an amount obtained by subtracting said predetermined amount from said credit limit represented by said identification code as a new credit limit represented by said identification code after determining to generate said information representing said predetermined amount (i.e., “the escrow account is decreased by the same value”).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 45, 46, 47, 49, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biffar.

Biffar discloses the recording medium as stated supra including generating a plurality of electronic notes having amounts whose total is substantially equal to the amount of the electronic note (col. 14, lines 5-25). Biffar does not explicitly disclose that the electronic note is supplied

Art Unit: 3621

together with separation information and the amounts of the plurality of electronic notes are represented by the separation information. However, Biffar states the use of "a customized mix evaluating parameters such as current vouchers available and typical size of transactions." Thus, it would have been within the level of ordinary skill in the art to send the electronic note with separation information and to use the separation information for the amounts of the plurality of electronic notes to optimize mix or to obtain a customized mix of vouchers. Further, the use of electronic note of Biffar for a contract device (i.e., paying for purchase of goods or services) would have been within the level of ordinary skill in the art.

10. Claims 1, 3-20, and 44 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P. Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks
Washington D.C. 20231***

or faxed to:

(703)305-7687

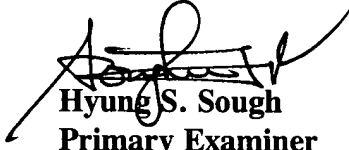
[Official communications; including
After Final communications labeled

Art Unit: 3621

"Box AF"]

(703) 746-8177 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.



Hyung S. Sough
Primary Examiner
Art Unit 3621

shs
October 1, 2002